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REMARKS

At the time of the Office action, claims 1-35 were pending in the application. Claims 1-8, 10-21, 24-32 and 35 were rejected. Claims 9, 22-23 and 33-34 were objected to as being dependent upon a rejected base claim. Claims 1-35 remain pending in the application.

Throughout this Response, any reference to the current application will cite to the corresponding U.S. Patent Application Publication No. 2004/0206522 ("App. '522").

Rejection of Claims 1 and 5-7 Under 35 U.S.C. § 102(b)

Claims 1 and 5-7 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,810,232 to Meurer ("Meurer"). Office Action ("OA"), p. 2. However, in order for Meurer to anticipate claims 1 and 5-7, Meurer must teach every element of each of claims 1 and 5-7. *See* MPEP § 2131; *see also, Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631 (Fed. Cir. 1987). Applicants respectfully contend that Meurer does not teach every element of each of claims 1 and 5-7.

Meurer teaches attaching a clip at a single position using a single attaching means for each tool. While the Meurer clip provides alternative attachments, aperture 16 and aperture 20, these alternative apertures do not allow attachment at multiple positions on a single tool. Rather, the two apertures allow attachment at a single position on each of a number of alternate tools. The example illustrated in the Meurer figures and described in the specification contemplates attaching the clip to the tool by inserting an air chuck through aperture 16. Meurer, col. 1, ll. 29-39. The clip may be oriented to either side of the tool, but the clip attaches by threading unto a single air chuck at a single position regardless of the orientation. *See id.*, FIGS. 1 & 4. Alternatively, aperture 20 may be used to attach the clip to a *different* tool by inserting a detachable handle through aperture 20. *Id.*, col. 1, ll. 40-45. Aperture 20 now becomes a single attachment at a single position on a different tool. Meurer does not teach, nor does it suggest, attaching a clip at multiple positions on a single tool.

In contrast, claim 1 recites the limitation:

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wherein the clip is selectively detachably mountable by a user to the housing at a first position through the use of the first attaching means and without the use of the second attaching means, and

the clip is selectively detachably mountable by a user to the housing at a second position different from the first position through the use of the second attaching means and without the use of the first attaching means.

Claim 1 recites a clip "mountable by a user to the housing at a first position" and "mountable by a user to the housing at a second position different from the first position." Therefore, claim 1 contemplates attachment of the clip at multiple positions on a *single* tool.

Because Meurer does not teach each of the limitations of claim 1, Applicants respectfully submit that Meurer does not anticipate claim 1, and claims 1 is allowable. Claims 5-7 depend from claim 1 and are allowable for at least the reasons that claim 1 is allowable.

Rejection of Claims 1-5 Under 35 U.S.C. § 103(a)

Claims 1-5 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Design Patent No. D345,465 to Greig ("Greig") in view of U.S. Patent Application Publication No. 2002/0179659 to Shaw ("Shaw"). OA, p. 3. In order to render a claim obvious by the combination of two or more references, three basic criteria must be met: (1) there must be some suggestion or motivation to combine the reference teachings; (2) there must be a reasonable expectation of success; and (3) the prior art references, when combined, must teach or suggest all the claim limitations. MPEP § 2143.

There must be some motivation or suggestion to combine the reference teachings. MPEP § 2143. In *In re Lee*, the Board of Patent Appeals stated, "The conclusion of obviousness may be made from common knowledge and common sense of a person of ordinary skill in the art without any specific hint or suggestion in a particular reference." 277 F.3d 1338, 1341 (Fed. Cir., 2002). The Court of Appeals for the Federal Circuit rejected this position holding that the Board of Appeals had committed "both legal error and arbitrary agency action." *Id.* at 1344. The Federal Circuit required that any finding of obviousness must be "based on objective evidence of record." *Id.* at 1343. Additionally, a finding of obviousness must be supported by "a suggestion,

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teaching, or motivation to combine the prior art references cited against the pending claims.” *In re Dembiczak*, 175 F.3d 994, 1000 (Fed. Cir. 1999). Therefore, a rejection for obviousness under 35 U.S.C. § 103(a) requires the identification of a specific “suggestion, teaching, or motivation” to combine prior art references. “The bores in the housing of Greig pass completely through the housing, therefore, providing *capability* to position the clip on either side of the housing.” OA, p. 3 (emphasis added). However, “the mere fact that references *can* be combined or modified does not render the resultant combination obvious . . .” MPEP § 2143.01; *In re Mills*, 916 F.2d 680 (Fed. Cir. 1990) (emphasis in original). Greig provides no suggestion or motivation to combine with the teachings of Shaw, and Shaw provides no suggestion or motivation to combine with the teachings of Greig. Therefore, Greig and Shaw cannot be properly combined to reject claims 1-5.

Additionally, the prior art references, when combined must teach or suggest all the claim limitations. MPEP § 2143. Greig in view of Shaw does not teach or suggest all the claim limitations. Claims 1-5 each, directly or by dependence, recite the limitation:

wherein the clip is selectively detachably mountable by a user to the housing at a first position through the use of the first attaching means and without the use of the second attaching means, and

the clip is selectively detachably mountable by a user to the housing at a second position different from the first position through the use of the second attaching means and without the use of the first attaching means.

Greig shows a clip mounted at a single position on the housing using a single attaching means. Greig does not teach or suggest that the clip should be attached at a second position on the housing using a second attaching means. Shaw shows a clip mounted at a single position on the housing using a single attaching means. Shaw does not teach or suggest that the clip should be attached at a second position on the housing using a second attaching means. The Examiner also appears to rely on Meurer in making this rejection. However, Meurer also does not teach or suggest that the clip should be attached at a second position on the housing using a second attaching means. Therefore the prior art references do not teach or suggest all the claim limitations.

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Finally, "the proposed modification cannot change the principle of operation of a reference." MPEP § 2143.01. As explained above, Applicants do not believe that Greig teaches a clip that is mountable at a first position and at a second position. However, the Examiner argues that, "The bores in the housing of Greig pass completely through the housing, therefore, providing capability to position the clip on either side of the housing." OA, p. 3. The Examiner later states, "It would have been obvious to one having ordinary skill in the art . . . to replace the through bores on either side of Greig with the non-through bores of Shaw" The Examiner suggests that it would be obvious to replace the very feature that the Examiner argues makes first and second mounting positions obvious. Applicants respectfully contend that this would fundamentally change the principle of operation that the Examiner imputes to Greig.

Applicants believe, for at least the reasons stated herein, that claims 1-5 are allowable and respectfully request that the rejection of these claims be withdrawn.

Rejection of Claims 2, 8 and 10-13 Under 35 U.S.C. § 103(a)

Claims 2, 8 and 10-13 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Meurer in view of U.S. Patent Application No. 4,956,865 to Hayasaka ("Hayasaka"). OA, p. 4.

Claims 2 and 8

Claims 2 and 8 depend from independent claim 1. As discussed above, claim 1 is not anticipated by, nor obvious over, Meurer. The combination of Hayasaka with Meurer does not render claim 1 obvious; therefore, claims 2 and 8 cannot be obvious over Meurer in view of Hayasaka. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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Claims 10-13

As discussed above regarding claims 1-5, a rejection for obviousness under 35 U.S.C. § 103(a) requires the identification of a specific "suggestion, teaching, or motivation" to combine prior art references "based on objective evidence of record." Meurer provides no suggestion or motivation to combine with the teachings of Hayasaka, and Hayasaka provides no suggestion or motivation to combine with the teachings of Meurer. Therefore, Meurer and Hayasaka cannot be properly combined to reject claims 10-13.

Additionally, the prior art references, when combined must teach or suggest all the claim limitations. MPEP § 2143. Meurer in view of Hayasaka does not teach or suggest all the claim limitations. Claims 10-13 each, directly or by dependence, recite the limitation of an "indexing projection" and an "indexing projection receiving recess." The projection 36 of Hayasaka is not an "indexing projection" as described in the application. *See* App. '522, para. 0045. Therefore the prior art references do not teach or suggest all the claim limitations.

Applicants believe, for at least the reasons stated herein, that claims 10-13 are allowable and respectfully request that the rejection of these claims be withdrawn.

Rejection of Claims 3 and 4 Under 35 U.S.C. § 103(a)

Claims 3 and 4 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Meurer in view of Hayasaka, and further in view of Shaw. OA, p. 6. Claims 3 and 4 depend from independent claim 1. As discussed above, claim 1 is not anticipated by, nor obvious over, Meurer. The combination of Hayasaka and Shaw with Meurer do not render claim 1 obvious; therefore, claims 3 and 4 cannot be obvious over Meurer in view of Hayasaka, and further in view of Shaw. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

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Rejection of Claims 14-19 and 26-30 Under 35 U.S.C. § 103(a)

Claims 14-19 and 26-30 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over U.S. Patent No. 5,372,206 to Sasaki ("Sasaki") in view of Greig and Meurer. OA, p. 7.

As discussed above regarding claims 1-5, a rejection for obviousness under 35 U.S.C. § 103(a) requires the identification of a specific "suggestion, teaching, or motivation" to combine prior art references "based on objective evidence of record." Sasaki provides no suggestion or motivation to combine with the teachings of Greig and Meurer, nor do Greig or Meurer provide any suggestion or motivation to combine with the teachings of Sasaki. Therefore, Sasaki, Greig and Meurer cannot be properly combined to reject claims 14-19 and 26-30.

Additionally, the prior art references, when combined must teach or suggest all the claim limitations. MPEP § 2143. Sasaki in view of Greig and Meurer does not teach or suggest all the claim limitations. Claims 14-19 and 26-30 each, directly or by dependence, recite the limitation of a clip or a means for holding "selectively detachably mountable by a user to the housing in at least *two separate positions*: a first position where the clip [means for holding] is on the first side of the housing and a second position where the clip [means for holding] is on the second side of the housing." (emphasis added). Neither Sasaki, nor Greig, nor Meurer teach a clip or means for holding mountable in at least two separate position. The Examiner alleges that the clip of Greig is capable of being mounted in at least two separate position, but as discussed above, just because a reference can be modified in a certain way does not make such a modification obvious. Therefore the prior art references do not teach or suggest all the claim limitations.

Further, regarding claims 15-19 and 27-30, claims 15 and 27 recite the limitation that:

the barrel portion has a top side portion, a bottom side portion generally opposite the top side portion, a first side portion, a second side portion generally opposite the first side portion, . . . ; and

the first position is on the first side portion, and the second position is on the second side portion.

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None of the cited prior art teaches or suggests a mounting position on a side portion of a barrel . Sasaki teaches a clip positioned on the top portion of the barrel portion exactly as shown by the prior art illustrated in FIG. 1 of the application. It is not clear that Meurer teaches a barrel portion and a hand grip portion as required by claims 14-19 and 26-30, but the Meurer clip does not attach to any portion that could be considered a barrel portion. Finally, the Greig clip does not attach to a barrel portion. Therefore, the prior art does not teach or suggest all the limitations of claims 15-19 and 27-30.

Applicants believe, for at least the reasons stated herein, that claims 14-19 are allowable and respectfully request that the rejection of these claims be withdrawn.

Rejection of Claims 20-21, 24-25, 31-32 and 35 Under 35 U.S.C. § 103(a)

Claims 20-21, 24-25, 31-32 and 35 were rejected under 35 U.S.C. § 103(a) as allegedly being obvious over Sasaki in view of Greig and Meurer, and further in view of Hayasaka. OA, p. 10. Claims 20-21 and 24-25 depend from claim 19, and claims 31-32 and 35 depend from claim 30. As discussed above, claims 19 and 30 are not anticipated by, nor obvious over, Sasaki in view of Greig and Meurer. The addition of Hayasaka does not render claims 19 and 30 obvious; therefore, claims 20-21, 24-25, 31-32 and 35 cannot be obvious over Sasaki in view of Greig and Meurer, and further in view of Hayasaka. "If an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is nonobvious." MPEP § 2143.03; *In re Fine*, 837 F.2d 1071 (Fed. Cir. 1988).

Conclusion

Applicants believe that all of the rejections and objections in the Office action have been addressed by the remarks above. If there are any questions concerning this Response, Applicants would welcome a telephone call or interview with the undersigned Applicants' representative.

A petition for a two-month extension of time and the appropriate fee accompany this response. If any additional fees are due, the Commissioner is authorized to debit those fees from the undersigned's Deposit Account No. 50-0206.


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Respectfully submitted,

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